Remarks

Claims 1-5, 7, 9, and 11 are pending in the application. Claims 6, 8, 10, and 12-20 have been cancelled.

I. Election

Applicant hereby elects Group I, claims 1-11 for prosecution as agreed to during a telephone conference with Examiner Asinovsky on October 27, 2004. Therefore, claims 12-20 have been cancelled.

II. 102(b) Rejections

Claims 1-11 were rejected under 35 U.S.C. 102(b) as being anticipated by International Published Application WO 96/11236 to Palumbo et al. ("Palumbo") and further as being anticipated by U.S. Patent 6,034,159, issued to Malcolm ("Malcolm"). It is respectfully submitted that claims 1-11 are not anticipated by either Palumbo or Malcolm.

A. Claim 1 Is Not Anticipated by Palumbo

Claim 1, as amended, is directed to a hot melt thermoplastic elastomer composition having a shear storage modulus of greater than about 3×10^6 dynes/cm^2 over a temperature range of between about 0° C and about 60° C.

Palumbo, in contrast, does not teach or suggest such a composition. Palumbo does not disclose any composition having a shear storage modulus as claimed in claim 1. In fact, Palumbo does not disclose any shear storage modulus information. While it is asserted in the Office Action that the shear storage modulus of claim 1 as amended would be expected to be similar to the Palumbo composition, Applicants respectfully submit that there is no reason to expect any similarity as to shear storage modulus. It would be understood by those of skill in the art that there is no reason to expect that the Palumbo composition would have a shear storage modulus of greater than about 3×10^6 dynes/cm^2 over a temperature range of between about 0° C and about 60° C. Thus, Palumbo fails to teach or suggest the invention of claim 1. Reconsideration and withdrawal of the rejection is respectfully requested.

B. Claim 1 Is Not Anticipated by Malcolm

Claim 1, as amended, is directed to a hot melt thermoplastic elastomer composition. In the instant application, "elastomer" and "elastomeric" are defined as pertaining "to materials that are capable of being elongated or deformed under an externally applied force, and which will substantially resume their original dimension or shape, sustaining only small permanent set . . . after the external force is released." See Present Application, page 7, ll. 22-27.

Malcolm, in contrast, does not teach or suggest a hot melt thermoplastic elastomer composition. Rather, Malcolm discloses an adhesive that has an "elongation at break of greater than about 2200%." Malcolm fails to teach or suggest a material capable of being elongated or deformed and which will "*substantially resume their original dimension or shape.*" Id. In fact, Malcolm states that the adhesive has an elongation of greater than about 2200% "*at break.*" Nowhere in the Malcolm is it taught or suggested that the Malcolm adhesive resumes its original dimension or shape after elongation or deformation. Malcolm, therefore, fails to teach or suggest a "hot melt thermoplastic elastomer composition" as claimed in claim 1. Reconsideration and withdrawal of the rejection is respectfully requested.

C. Claims Depending from Claims 1 Are Patentable

Because claims 2-5, 7, 9, and 11 depend directly or indirectly from claim 1 and incorporate all the limitations of claim 1, the above argument obviates the bases for these grounds of rejection. Thus, claims 2-5, 7, 9, and 11 are not anticipated by Palumbo or Malcolm. Reconsideration and withdrawal of the rejections is respectfully requested.

Conclusion

Claims 1-5, 7, 9, and 11 are allowable. Reconsideration and a Notice of Allowance for all pending claims is respectfully requested.

No fees are due in connection with this filing. However, the Commissioner is authorized to charge any additional fees, including extension fees or other relief that may be required, or credit any overpayment to Deposit Account No. 04-1420.

Respectfully submitted,

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